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Paper No. 17
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tritex Corporation

Serial No. 75/024,851

Martin P. Hoffman of Hoffman, Wasson & Gitler, PC for
Tritex Corporation.

Lesley LaMothe, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Seeherman, Quinn and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On November 28, 1995 Tritex Corporation (a California corporation) filed an application to register the mark CONTOUR for "ladies' clothing, namely, corsets, girdles, body-shapers, and waist-liners" in International Class 25. The application is based on applicant's claimed first use date of December 31, 1975 and first use in commerce date of March 1980.

The Examining Attorney initially refused registration on two bases - (i) under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's

mark is merely descriptive of the identified goods; and (ii) under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified goods, so resembles the registered mark, CONTOURS, for "women's clothing, namely, panties,"¹ as to be likely to cause confusion, mistake or deception.

In response thereto, applicant argued against both refusals to register, and offered an amendment to change the preamble of the identification of goods from "ladies' clothing, namely,..." to "foundation garments for women, namely,...." The Examining Attorney accepted the amendment to the identification of goods, withdrew the refusal to register under Section 2(e)(1) of the Trademark Act, and made the refusal to register under Section 2(d) final.

Following the denial of a request for reconsideration, applicant then offered an amended identification of goods to "foundation garments for women, namely, body shapers," and an amendment to the method-of-use clause to state that "the goods are sold, via mail order, in response to advertisements placed in Spanish language publications." The Examining Attorney accepted the amendment to the identification of goods, noted that the amendment to the

¹ Registration No. 1,772,450, issued May 18, 1993, Section 8 affidavit accepted, Section 15 acknowledged.

method-of-use clause does not limit the identified goods and therefore does not effectively limit or narrow applicant's trade channels, and maintained the final refusal to register under Section 2(d).

Applicant appealed. Briefs have been filed², but an oral hearing was not requested. We affirm the refusal to register. In reaching this conclusion, we have considered all of the relevant du Pont³ factors which are applicable to this case.

Turning first to the marks, we find that they are virtually identical in sound, appearance, connotation and commercial impression. The fact that the registered mark has a final "S," while applicant's mark has no final "S," does not distinguish the marks. Consumers are not likely to notice the presence or absence of the letter "S" when viewing the marks individually. And, under actual market conditions, consumers often do not have the luxury to make

² In applicant's brief on appeal, applicant offered another amendment to the identification of goods to "foundation garments for women, namely, body shapers sold via mail order." The proper procedure to offer an amendment at this stage would have been a request for remand. In the Examining Attorney's brief, she made no reference to the proposed amendment. Thus, the Board cannot treat the amendment as having been consented to by the Examining Attorney. We point out that the amendment would not overcome the Section 2(d) refusal as there is no limitation in the cited registration relating to trade channels.

³ See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

a side-by-side comparison between marks, and instead must rely on hazy past recollections. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

Both registrant's mark CONTOURS and applicant's mark CONTOUR connote the same idea of a shapely figure, especially in relationship to the involved goods.

With respect to the goods, it is not clear that there is a significant difference between these goods, particularly if panties are made of a "shaping" or "control" type of material. In any event, it is well settled that goods need not be identical or even competitive to support a finding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, or that the circumstances surrounding their marketing are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they emanate from or are associated with the same source. See *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 596 (TTAB

1978); and In re Peebles Inc., 23 USPQ2d 1795, 1796 (TTAB 1992).

In support of her position as to the relatedness of the respective goods, the Examining Attorney has made of record copies of pages from catalogs (e.g., Chic and Victoria's Secret) showing that the same companies sell a variety of undergarments such as panties and bras, as well as bodysuits and bustiers. The Examining Attorney also submitted copies of third-party registrations which issued on the basis of use in commerce,⁴ to demonstrate the relationship between applicant's goods (body shapers) and registrant's goods (panties), by showing that a single entity has adopted a single mark for intimate apparel similar to the goods at issue (e.g., undergarments and bodysuits).

Third-party registrations, of course, are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. Nevertheless, third-party registrations which individually cover a number of different items and which are based on use in commerce have some probative value to the extent they suggest that the

⁴ As to any of the third-party registrations which were not based on use in commerce, we did not consider these in reaching our decision.

listed goods emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

Applicant's own specimens of record show a model wearing a bra, panties and a body shaper.

Based on the record before us, we readily conclude that applicant's goods are closely related to registrant's goods.

Regarding the respective trade channels and purchasers, both identifications of goods specifically refer to women's clothing, applicant's being body shapers and registrant's being panties. While applicant attempted at the briefing stage to limit its identification of goods to those "sold via mail order," there is no limitation as to trade channels in registrant's identification of goods. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Thus, the cited registrant's goods would include all normal methods of sale, including mail order. Applicant's argument that "it relies primarily upon mail order sales to a Spanish-speaking population within the United States (and within adjacent countries)" (brief, p. 2) is unavailing because applicant's identification of goods is not limited to the

Spanish-speaking population of the United States. In fact, applicant's specimen is printed in both English and Spanish. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Decision: The refusal to register under Section 2(d) is affirmed.